

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings (MPEP §2142). Additionally, the prior art reference (or references when combined) must teach or suggest all the claim limitations (MPEP §2142).

All of the references fail to provide suggestion or motivation to include “manually selecting an individual prospect and an individual commercial”. Additionally, there is no suggestion or motivation in the knowledge generally available to one of ordinary skill in the art to modify any of the references to include a manual selection step. In fact, general knowledge would lead the person of ordinary skill away from a manual step, because it is presumably less efficient, more costly, and more time consuming. Since there is no suggestion or motivation to modify the references, and the claimed references either by themselves or in combination do not teach or suggest all of the claimed limitations, a prima facie case of obviousness has not been established.

Performing a step manually is non-obvious when an automated method is available. The person of ordinary skill is imputed with the general knowledge available in the art as of the priority date of the inventive subject matter. Here, that knowledge includes the preference of automated systems and methods over manual systems and methods, especially when sending out advertising. While it may be obvious to automate a manual operation because of speed, efficiency, and cost, among other things, it is counterintuitive, and non-obvious, to take an automated operation and make it manual when the automated method is available.

It is not obvious to include a manual step in a large-scale distribution system, even if there is a system failure. All of the references are large-scale distribution systems that would be too difficult and costly to operate manually in the case of system failure. One of ordinary skill in the art would be more inclined to have other less burdensome alternatives at hand, such as a backup system that would still perform the process in an automated fashion. Attempting to incorporate manual operation in a reference teaching large-scale distribution is analogous to cutting a lawn with a scissors just because your lawnmower is broken – there are other much better alternatives, and manual operation is not one of them.

Claims 1-12 are pending in this application. The applicant requests allowance of all pending claims.

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